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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/384,967	08/30/1999	KUNIHIRO YAMAMOTO	862.2991	8547

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EXAMINER

PATEL, KANJIBHAI B

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 09/29/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/384,967

Applicant(s)

YAMAMOTO ET AL.

Examiner

Kanji Patel

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6, 10, 15, 19-23, 26-32, 35-38 and 50-53 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1, 6, 10, 15, 19-23, 26-32, 35-38, 50-53 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Response to Amendment

1. Applicant's amendment filed 6/16/03 (Paper No. 9) has been entered.

Applicant's arguments with respect to claims 1, 10, 19, 20, 29 and 38 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 10, 19, 20, 29 and 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, 10, 13, 16, 19, 20, 21, 22 of copending Application No. 09/384,968. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the application No. 09/384,968 and both applications are claiming common subject matter as follows:

For example, claim 1 of the instant application encompasses subject matter that overlaps with the subject matter covered by claim 1 of the reference application

09/384,968. Specifically, the instant application and the reference application 09/384,968 include **display means** for displaying a plurality of image data as a search result, image **feature amount computing** means for computing a image feature amount of the image input, **image similarity computing means** for computing image similarity and selection means for selecting image data designated by a user from the plurality of image data (is provided by the input means). While the reference application includes an additional details regarding the parallel processing, the use of the transitional term "comprising" in the claims fails to preclude the presence of additional features not specifically claimed in the instant application. Since both the applications include substantially (except parallel processing) identical disclosure including figures 1, 2, 4-9 of the instant application which correspond to figures 1, 2, 4-9 of the reference application are used for calculating the above similar limitations in claim 1 of both the applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 6, 10, 15, 19-23, 26-32, 35-38, 50-53 are rejected under 35 U.S.C.

102(e) as being anticipated by Sato et al. (hereinafter Sato) (US 6,181,818 B1-- IDS).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

For claims 1, 10 and 19, Sato discloses an image search apparatus for searching an image database for desired image data, the image database storing a plurality of image data in correspondence with image feature amounts for each of the image data (figures 1-2 and 41), said apparatus comprising:

display means (element 111 in figures 1 and 3) for displaying a plurality of image data as a search result, corresponding to an input search condition (column 7, lines 19-46), obtained by a search of image data from the image database (column 7, lines 19-46);

selection means for selecting image data designated by a user from the plurality of image data (column 7, lines 19-30);

image feature amount computing means for computing an image feature amount of the image data selected by said selection means (figure 1, elements 109 -110; figure 41, element 41);

image similarity computing means for computing image similarity on the basis of the image feature amount computed by said image feature amount computing means, and the image feature amounts of the image data stored in the image database.(column

5, lines 50-55; column 6, lines 25-53) a similarity calculation processor 10 in figure 1 provides a similarity computing means; also in figure 26, step S84 provides a calculation of similarity of candidate region).

For claims 6 and 15, Sato discloses an apparatus, wherein said display means comprises search means for searching for desired image data by designating information appended to the image data (202 in figure 2), and when a search is made by said search means, said display means displays a list of image data found by the search of said search means (203 in figure 3 provides image data found by the search).

For claims 20, 29 and 38, Sato discloses an image search apparatus for searching an image database for desired image data, the image database storing a plurality of image data in correspondence with image feature amounts for each of the image data (figures 1-2 and 41), said apparatus comprising:

display means (element 111 in figures 1 and 3) for displaying a plurality of image data searched on the basis of input handwritten information(column 7, lines 19-46).

selection means for selecting color information (202 in figure 3) of image data designated by a user from the plurality of image data (column 7, lines 19-30);

image feature amount computing means for computing an image feature amount of an image drawn in a drawing area, which includes having color information selected by said selection means (figure 1, elements 109 -110; figure 41, element 41);

image similarity computing means for computing image similarity on the basis of the image feature amount computed by said image feature amount computing means, and the image feature amounts of the image data stored in the image database.(column

5, lines 50-55; column 6, lines 25-53) a similarity calculation processor 10 in figure 1 provides a similarity computing means; also in figure 26, step S84 provides a calculation of similarity of candidate region).

For claims 21 and 30, Sato discloses an apparatus wherein the color information is selected by indicating one pixel in the image data (at least step 301 in figure 4 provides color information).

For claims 22 and 31, Sato discloses an apparatus wherein the color information is selected by indicating a predetermined region in the image data (figures 4 and 21).

For claims 23 and 32, Sato discloses an apparatus wherein the color information designated by indicating the predetermined region is an average value of pixel values contained in the small region (column 7 line 66 to column 8 line 3).

For claims 26 and 35, Sato discloses an apparatus wherein the color information is selected on the basis of an image drawn on the drawing area (204 in figure 3).

For claims 27 and 36, Sato discloses an apparatus wherein said image feature amount computing means computes the image feature amount of the drawn image each time the image in the drawing area is modified (figures 41, 51).

For claims 28 and 37, Sato discloses an apparatus further comprising display control means for controlling a display of the drawing area within a display window displayed by said display means (a display selection unit 137 in figure 31 provides a display control by selcting the display image).

For claim 50, Sato discloses an apparatus, wherein the image data selected by said selection means is copied in a drawing area 9figure 3); and wherein said image similarity computing means computes image similarity on the basis of an image feature amount, computed by said image feature amount computing means, of the image data copied in the drawing area, and the image feature amounts of the image data stored in the image database (figures 2, 41, 51).

For claim 51, Sato discloses an apparatus further comprising modifying means for modifying the image data copied in the drawing area; wherein said image similarity computing means computes image similarity on the basis of an image feature amount, computed by said image feature amount computing means, of the image data modified by said modifying means, and the image feature amounts of the image data stored in the image database (figures 2, 41, 51).

For claim 52, Sato discloses an apparatus, wherein said the plurality of image (203 in figure 3) data displayed by said display means is displayed on the basis of image similarity computed by said image similarity computing means (column 7, lines 29-32).

For claim 53, Sato discloses an apparatus, wherein the drawing area (201 in figure 3 is a drawing area; column 7, lines 25-27) and the plurality of image data (203 in figure 3; column 7, lines 29-32) are displayed in the same window (111 in figure 3 is a same window for both the drawing area and the retrieval results of the plurality of image data in the order of the similarity values).

Contact information

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kanji Patel whose telephone number is (703) 305-4011.

The examiner can normally be reached on 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Bhavesh Mehta** can be reached on (703) 308-5246.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



Kanji Patel
Art Unit 2625
September 21, 2003